

### Remarks

Claims 1 to 4 are pending. Claim 2 has been cancelled and introduced as new Claim 7. Claims 5 and 6 have been added. To facilitate the understanding of this response, Applicant has set forth Applicant's arguments in specific headed paragraphs. Favorable reconsideration of this application as amended is requested.

#### Rejection under 35 U.S.C. § 112, second paragraph

Claims 1-4 stand rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that Applicant regards as the invention.

The Examiner has stated that it appears to the Examiner that Applicant's "fluorine copolymer" substantially overlaps his claimed "hydrophilic agent" as disclosed in his application. The Examiner has requested clarification. Further, the Examiner has stated that a "coating" adhesive sheet as set forth in claims 3 and 4 is believed to be improper grammar.

Applicant respectfully submits that according to the Specification, the fluorine copolymer "may be any copolymer containing a fluorine atom in a molecule, but is preferably a copolymer containing a vinylidene fluoride unit in the molecule" (Specification, page 9, lines 4-6).

Furthermore, according to the Specification, the hydrophilic agent is preferably "a compound represented by the following general formula (I): Z-X-O-Rf wherein Z represents an organic group, X represents -C=O (carbonyl group) or -SO<sub>2</sub> (sulfonyl group), and Rf represents an organic group which may contain an oxygen atom, in which all or a portion of hydrogen atoms are substituted with fluorine atom(s)" (Specification, page 10, lines 7-13). Additional representative examples of a hydrophilic agent useful in the present invention can be found on page 11 of the Specification.

Applicant has amended Claims 1 and 4 to make it clear that no overlap exists between the "fluorine co-polymer" and the "hydrophilic agent."

The Examiner has suggested that the 35 U.S.C. § 112, second paragraph rejection might "perhaps [be] a 35 U.S.C. § 112, first paragraph rejection." Applicant's attorney is unable to respond to this suggestion, since the Examiner has not actually rejected the claims on the basis of

35 U.S.C. § 112, first paragraph. Such a rejection would require the Examiner to provide a statement based upon the criteria set forth in MPEP §§ 2164-2164.08(c).

Regarding the phrase a "coating" adhesive sheet as set forth in claims 3 and 4, Applicant has named this particular sheet to be a coating adhesive sheet. While the Examiner may believe this terminology to be improper grammar, Applicant is entitled to be his own lexicographer and has defined a "coating adhesive sheet" as comprising a flexible substrate, an adhesive layer and a protective layer, wherein the protective layer is a thermoplastic resin layer comprising a fluorine copolymer, a non-fluorine copolymer and a hydrophilic agent (See Specification, page 2, line 26-30).

However, to advance prosecution Applicant has amended Claims 1, 3 and 4 to provide greater clarification. Claim 1 now refers to an adhesive sheet having a first flexible substrate, a first adhesive and a first protective layer (See Specification page 3, line 21-22). Claims 3 and 4 have been amended to clarify that the coating adhesive sheet is another adhesive sheet having a second flexible substrate, a second adhesive layer and a second protective layer, wherein the second adhesive sheet is applied to the surface of the protective layer of the first adhesive sheet (See Specification page 3, line 20-21 and page 5, line 33 to page 6, line 8).

Applicant has cancelled Claim 2 and added new Claims 5-7. New Claim 7 is Claim 2 (now cancelled) rewritten to include multiple dependency to Claims 1 and 4.

In summary, Applicant submits that the rejections of claims 1, 3 and 4 under 35 USC § 112, second paragraph, have been overcome, and that the rejection should be withdrawn.

#### **Rejection under 35 U.S.C. § 103 (a)**

Claims 1-4 stand rejected under 35 USC § 103(a) as being unpatentable over EPA 467570A2 taken in view of Japanese Patent Abstract 08-337771.

The Examiner has stated that EPA 467570A2 substantially anticipates the entire claimed genus of adhesive sheets and also the coating adhesive sheets set forth in Applicant's claim 4, with the only lacking element being the presence of the hydrophilic agent. The Examiner has stated that the claims are lacking this element, but the Examiner states that the lacking element is disclosed in the secondary reference.

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The secondary reference cited by the Examiner is directed to the hydrophilic agent used in the present invention. However, without the present invention to point out the advantages of this combination, there is no suggestion in the primary reference to include a hydrophilic agent, much less the class of hydrophilic agents described in the secondary reference. Furthermore, the agent described in the secondary reference (JP Abstract 08-337771) is specifically used as a stain-preventing agent in paints (Paragraph [0008]), not adhesive sheets.

Without the claims of the present invention as a blueprint, the combination fails. Applicant respectfully submits that the mere ability to include a component from one reference (JP Abstract) into the composition described in another reference (EP '570) is not determinative of obviousness. (*The Gentry Gallery v. The Berkline Corp.*, 45 USPQ2d 1498, 1502 (Fed. Cir. 1998). The possibility that the two references could have been combined is insufficient and Applicant submits that absent the present claims, there is no motivation to enhance what has already been described as articles that are "surprisingly very resistant to dirt, stains and other weather elements." (EP '570, col. 1, lines 53-54).

Applicant respectfully submits that the rejection of claims 1, 3 and 4 under 35 USC § 103(a) has been overcome.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application is requested.

Respectfully submitted,

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Date

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